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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/820,054	Applicant(s) SCHRAN ET AL.	
	Examiner Etienne P LeRoux	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Claims Status

Claims 1-30 are pending. Claims 1-30 are rejected as detailed below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,826,242 to Montulli in view of Pub No US 2004/0230820 to Hui Hsu et al (hereafter Hui Hsu).

Claims 1 and 16:

Montulli discloses:

Art Unit: 2161

- a) receiving at a server, a request from a subscriber to send a file to the client machine [Fig 1A and col 4, lines 38-52]
- b) downloading the file to the client machine [col 4, lines 38-52]
- c) using the downloaded list to detect files received at the client machine from sources on the downloaded list [col 9, lines 52-62].

Montulli discloses a file such as a list of cookie file sources located at the client computer but is silent regarding a list of cookie file sources at the server. Hui Hsu discloses a list of cookie file sources at the server [database unit 32, Fig 1, paragraph 58, paragraph 89]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Montulli to include a list of cookie file sources at the server for the purpose of controlling what cookies can be passed to the client [paragraph 57]. The skilled artisan would have been motivated to improve the invention of Montulli per the above such that undesirable cookies are not stored at the client computer [paragraph 57]. Also, the combination would have rendered a system that would allow cookies to be updated routinely without having to “handshake” with the client – a very desirable result in an environment where IP addresses change continuously.

Claims 1, 3, 6, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,282,709 to Reha et al (hereafter Reha) and further in view of Pub No US 2004/0230820 to Hui Hsu et al (hereafter Hui Hsu).

Claims 1 and 16:

Reha discloses:

Art Unit: 2161

- a) receiving at a server, a request from a subscriber to send a file to the client machine [col 2, lines 1-8]
- b) downloading the file to the client machine [col 2, lines 1-8]
- c) using the downloaded list to detect files received at the client machine from sources on the downloaded list [col 2, lines 1-8]

Reha discloses downloading a file list but is silent regarding a list of cookie file sources. Hui Hsu discloses a list of cookie file sources [ID number of each web site in paragraphs 58 and 63]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Reha to include a list of cookie file sources as taught by Hui Hsu for the purpose of determining by a server which cookie(s) are appropriate to forward to a web site making a request [paragraph 62].

Claims 3, 18 and 24:

The combination of Reha and Hui Hsu discloses receiving updates of the downloaded list from the server on a periodic basis [paragraph 25, Hui Hsu]

Claims 6, 15, 21, 26 and 30:

The combination of Reha and Hui Hsu discloses preventing detected cookie files from being stored in the client machine [paragraph 51, Hui Hsu].

Claims 2, 8-15, 17 and 20-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Reha and Hui Hsu and further in view of US Pat No 6,023,723 to McCormick et al (hereafter McCormick).

Claims 2 and 17:

The combination of Reha and Hui and Hsu discloses the elements of claim 1 as noted above. Furthermore, Hui Hsu discloses (d) creating a first exception list including the identity of sources that are permitted to store cookie files in the machine [paragraph 58] and (e) creating a second exception list including the identity of sources that are not permitted to store cookie files in the client machine [paragraph 51] but fails to disclose modifying the downloaded list in accordance with the first and second exception lists. McCormick discloses modifying the downloaded list in accordance with the first and second exception lists [abstract, user's system is modified per the "not receive list" and the "to receive list"]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Reha and Hui Hsu to include modifying the downloaded list in accordance with the first and second exception lists for the purpose of filtering junk e-mails [abstract]. The skilled artisan would have been motivated to improve the invention of Reha and Hui Hsu per the above such that a user's time is saved by not having to review e-mails that he/she is not interested in.

Claims 7 and 22:

Reha discloses (c) receiving at the client machine, from a service provider, a master list of cookie file sources [col 2, lines 1-8] but fails to disclose (a) creating a first exception list including the identity of sources that are permitted to store cookie files in the client machine and (b) creating a second exception list including the identity of sources that are not permitted to store cookie files in the client machine. Hui Hsu discloses (a) creating a first exception list including the identity of sources that are permitted [paragraph 58] to store cookie files in the client machine and (b) creating a second exception list including the identity of sources that are not permitted [paragraph 62] to store cookie files in the client machine.

Art Unit: 2161

The combination of Reha and Hui Hsu discloses the elements of instant claim as noted above but fails to disclose modifying the master list in accordance with the first and second exception lists, wherein the composite list is the modified master list. McCormick discloses modifying the downloaded list in accordance with the first and second exception lists [abstract, user's system is modified per the "not receive list" and the "to receive list"]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Reha and Hui Hsu to include modifying the downloaded list in accordance with the first and second exception lists for the purpose of filtering junk e-mails [abstract]. The skilled artisan would have been motivated to improve the invention of Reha and Hui Hsu per the above such that a user's time is saved by not having to review e-mails that he/she is not interested in.

Claims 8, 13, 23 and 28:

The combination of Reha, Hui Hsu and McCormick discloses the elements of claim 7 as noted above. Furthermore, Hui Hsu discloses wherein the composite list is stored in the client machine independent of the first exception list, the second exception list and the received master list [paragraph 51].

Claims 9 and 24:

The combination of Reha, Hui Hsu and McCormick discloses the elements of claim 7 as noted above. Furthermore, Hui Hsu discloses receiving updates of the downloaded list from the server on a periodic basis [paragraph 25]

Claims 10, 14, 20, 25 and 29:

The combination of Reha, Hui Hsu and McCormick discloses the elements of claim 7 as noted above. Furthermore, McCormick discloses removing stored files at the client machine from sources on the composite list [abstract].

Claims 11, 15, 21, 26 and 30:

The combination of Reha, Hui Hsu and McCormick discloses the elements of claim 7 as noted above. Furthermore, Hui Hsu discloses preventing detected cookie files from being stored in the client machine [paragraph 51].

Claims 12 and 27:

Reha discloses (a) receiving at the client machine, from the service provider, a master list of file sources [col 2, lines 1-8] but does not disclose downloading a file list but is silent regarding a list of cookie file sources. Hui Hsu discloses a list of cookie file sources [ID number of each web site in paragraphs 58 and 63]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Reha to include a list of cookie file sources as taught by Hui Hsu for the purpose of determining by a server which cookie(s) are appropriate to forward to a web site making a request [paragraph 62]. Furthermore, Hui Hsu discloses trusted [paragraph 51] and untrusted [paragraph 57] cookie file sources.

The combination of Reha and Hui Hsu discloses the elements of instant claim as noted above but fails to disclose (b) deleting cookie file sources from the master list that correspond to one or more file sources listed in the client machine (c) adding cookie file sources to the master list that correspond to one or more file sources listed in the client machine, wherein the composite list is the master list as modified by any additions and deletions of file sources. McCormick discloses

Art Unit: 2161

(b) deleting cookie file sources from the master list that correspond to one or more file sources listed in the client machine (c) adding cookie file sources to the master list that correspond to one or more file sources listed in the client machine, wherein the composite list is the master list as modified by any additions and deletions of file sources [abstract]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Reha and Hui Hsu to include (b) deleting cookie file sources from the master list that correspond to one or more file sources listed in the client machine (c) adding cookie file sources to the master list that correspond to one or more file sources listed in the client machine, wherein the composite list is the master list as modified by any additions and deletions of file sources for the purpose of filtering junk e-mails [abstract]. The skilled artisan would have been motivated to improve the invention of Reha and Hui Hsu per the above such that a user's time is saved by not having to review e-mails that he/she is not interested in.

Claims 4 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Reha and Hui Hsu and further in view of US Pat No 5,864,848 to Horvitz et al (hereafter Horvitz).

Claims 4 and 19:

The combination of Reha and Hui Hsu discloses the elements of claim 1 as noted above but fails to disclose displaying a message at the client machine indicating that a cookie file received from a source on the downloaded list has been detected. Horvitz discloses displaying a message at the client machine indicating that a cookie file received from a source on the downloaded list has been detected [col 2, lines 17-32]. It would have been obvious to one of

Art Unit: 2161

ordinary skill in the art at the time the invention was made to modify the combination of Reha and Hui Hsu to include displaying a message at the client machine indicating that a cookie file received from a source on the downloaded list has been detected as taught by Horvitz for the purpose of informing a user of an incoming e-mail [col 2, lines 17-32].

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Reha and Hui Hsu and further in view of US Pat No 5,826,242 to Montulli.

Claim 5:

The combination of Reha and Hui Hsu discloses the elements of claim 1 as noted above but fails to disclose removing the detected cookie files from the client machine. Montulli discloses removing the detected cookie files from the client machine [col 8, lines 30-35]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Reha and Hui Hsu to include removing the detected cookie files from the client machine as taught by Montulli for the purpose of deleting cookies that had expired [col 8, lines 30-35]. The skilled artisan would have been motivated to modify the combination of Reha and Hui Hsu per the above for the purpose of removing cookies which the client did not want to store on his/her computer.

Response to Arguments

Applicant's arguments filed 8/19/2004, have been considered but they are not fully persuasive.

Applicant Argues:

Applicant states on page 2 "All of the pending claims require a 'list of cookie file sources.' A cookie file source is defined on page 5, lines 28-29 of the specification as being a website, an e-business or any other entity that sends cookie files. A list of cookie file sources there is either a list of websites, a list of e-businesses, or a list of entities that send cookie files. A list of cookie file sources is completely different than a source of cookies (alternatively, referred to as cookie files), such as the list of cookies stored in the well-known cookies.txt file of a browser program. In one preferred embodiment of the present invention, the claimed list of cookie file sources may be used to manage the list of cookies stored in the cookies.txt file of a browser program. Montulli and Wagner both disclose the use of conventional list of cookies stored in a file of a browser program. However, neither Montulli nor Wagner disclose or suggest requesting, receiving, downloading, or using a list of cookie file sources as set forth in step (a) of claims 1, 12, 16 and 27, step (c) of claims 7 and 22, or any of the remaining steps in these claims that use the list of cookie file sources."

Examiner Responds:

Examiner is not persuaded. Montulli in column 4, lines 38-50, discloses downloading a file from a server to a user's computer. Furthermore, Montulli in column 9, lines 53-63 discloses a cookie list. Examiner maintains it would have been obvious to the skilled artisan to combine above features. However, without acquiescing to applicant's arguments, examiner provides

Art Unit: 2161

supra new art rejection in order to advance prosecution by avoiding unnecessary arguments regarding what comprises "a list of cookie file sources" and where it may or may not be stored.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022.


The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023. .

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Etienne LeRoux

12/06/2004


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